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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/563,963	08/04/2006	Hitoshi Takahashi	049400-5042	7351
9629 7590 05/20/2009 MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004				
EXAMINER				
BATTULA, PRADEEP CHOUDARY				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/563,963

Applicant(s)

TAKAHASHI, HITOSHI

Examiner

PRADEEP C. BATTULA

Art Unit

3725

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 10-13 is/are rejected.
- 7) ☒ Claim(s) 7-9 and 14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 August 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/003)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, tapping the spine after the adhesive is applied must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holmberg (U.S. 5,221,112) in view of Holzberg Jr. (Holzer; U.S. 3,973,764).

In regards to Claim 1, Holmberg discloses a book-making equipment 16 (Column 2, Lines 19 – 22; Figure 5, Item 16) in which a plurality of sheet papers 10 are laminated (Column 2, Lines 19 – 22 teaches of the folded stacked sheets; Column 2, Lines 37 – 45 teaches of the gluing which laminates the sheets to one another; Figures 1 - 3, Item 10; Figure 5), and one elevational end of the laminated sheet papers are bonded to produce a booklet (Column 2, Lines 37 – 45); said book-making equipment comprising; a pair of clutch pieces 16a, 16b placed perpendicular to a work table (Column 2, Lines 19 – 22; Figure 5, Items 16a, 16b), said clutch pieces having corresponding planar pressure surfaces longer than said elevational end of the laminated sheet papers (Column 2, Lines 37 - 45 teaches of the roller on each of the sheets and then applying the glue and if the sheets are not shorter than clutch pieces then the sheets would have openings where glue could get through in the unclamped areas; Figure 5, Items 16a, 16b also further shows that the device is clamped to a table where the clutch pieces 16a and 16b are perpendicular to the table) so as to releasably hold said one elevational end of the laminated sheet papers between said clutch pieces (Figure 5, Items 16a, 16b

shows that only the top portion of the sheets is covered on both sides); a clamping member provided to adjustably decrease a space between said pressure surfaces so as to clamp said one elevational end of said laminated sheet papers in such a direction as to depress said laminated sheet papers (Figure 5, Item 16 shows that a handle is turned and the threads advance the portion 16a to 16b which then clutches the sheet; Furthermore Holmberg teaches it is a vice and it is known that such have are threaded portions); a pushing member, the portion of 16b continuing below 16a and portion under 16a further pushing sheets, provided to true up said one elevational end or the other elevational end of said laminated sheet papers and push said one elevational end out of said pressure surfaces by a predetermined length (Figure 5, Items 16b, and square cross section member under 16a pushing on sheets; teaches and pressure is determined by a predetermined length of the distance between the clutch pieces 16a and 16b); a slack-prevention member (the slack prevention member taught in the drawings by applicant is just a surface of the pushing member) provided to engage with other portion of said one elevational end so as to prevent said laminated sheet papers from getting loose (interior surfaces of portion 16b continuing below 16a and the interior surface of portion under 16a);

Holmberg does not disclose said slack-prevention member having abutment surfaces each extending in parallel from one lower edge side of said pressure surfaces and radially bifurcated to engage with other portion of said one elevational end of the laminated sheet papers.

Holzberg teaches of a clamp having members 21, 22 used in clamping materials wherein the clamps are bifurcated (Column e3, Lines 6 – 9; Figure 7, Items 21, 22). Although it is taught that a blade is put through the clamps, it is shown that clamps work equally well when bifurcated. Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide the slack prevention members with bifurcations as such have been known to perform equally well with and without bifurcations.

Holzberg modified by Holzberg does not disclose the bifurcation is radial, however, such only yields a predictable results as providing less surface area for slack prevention and is only one of a finite amount of ways in which to produce a bifurcation in the slack prevention members (Applicant has pointed out the bifurcation and such allows for the invention to stand but such has not been claimed. A statement stating what the bifurcation is for [in addition to another surfaces allows the invention to independently stand] would overcome the rejection).

2. Claims 4 – 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holzberg in view of Goudie (U.S. 2,654,932) or Holzberg in view of Holzberg and Goudie.

In regards to Claim 4, Holzberg and Holzberg modified by Holzberg does not disclose wherein a side-trimming member is provided to engage with an elevational end side formed between said one elevational end and other elevational end of said laminated sheet papers so as to confine said laminated sheet papers to true up said elevational end side of said laminated sheet papers.

Goudie teaches of a paper clutching device wherein the device further contains a side trimming member 13b at one elevational end of the sheets in order to hold sheets in place (Column 2, Lines 17 - 27; Figure 2, Item 13b). Therefore it would have been obvious to a person having ordinary skill in the art to provide a side trimming member to the invention of Holmberg in order to hold the sheets clamped in place at an elevational end on both sides in order to align the sheets on their vertical edges (horizontally depending on the orientation of the device of Holmberg)

In regards to Claims 5 and 6, Holmberg further discloses an extension member/sheet size alteration member having a bolt and screw which hold the sheets from a certain distance from the work table surface and holds the sheets at one elevational end out of the pressure surfaces (Figure 5, Item holding the sheets at the lower end. It is seen that the sheets are supported at a distance away from the work table surface).

Goudie (U.S. 2,654,932) teaches of a paper clutching device wherein the device further contains a side member 13b at one elevational end of the sheets in order to hold sheets in place (Column 2, Lines 17 - 27; Figure 2, Item 13b) and further allows for adjustment by a set of screws and nuts in order to accompany different sized sheets (Column 2, Lines 22 - 31; Figure 2, Item 15). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide the extension member/sheet size alteration member of Holmberg in order to allow for the invention to accompany differently sized sheets (Such a modification would raise and lower the member from the table work surface).

Furthermore with respect to Claims 5 and 6, the extension member can be considered the top surface of the sheet alteration member with the sheet alteration member allowing for the accompanying different sized sheets with the sheet alteration member being that of as discussed in Figure 5 holding the sheets at the lower end.

3. Claims 10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holmberg in view of Blair (U.S. 3,668,037).

In regards to Claims 10 and 12, Holmberg discloses a book-making method using said book-making equipment 16 (Column 2, Lines 19 – 22; Figure 5, Item 16) comprising steps of: clamping one elevational end of said laminated sheet papers 10 (Column 2, Lines 19 – 22 teaches of the folded stacked sheets; Column 2, Lines 37 – 45 teaches of the gluing which laminates the sheets to one another; Figures 1 - 3, Item 10; Figure 5) with said one elevational end extended beyond said pressure surfaces by a predetermined length (Column 2, Lines 37 – 45 teach of providing adhesive and such cannot be done without extending beyond the pressure surfaces; Figure 5 shows a portion at the bottom holding the sheets at a certain vertical position so there is a predetermined height to where the sheets go beyond the clamps), applying adhesive to the exposed sheets at the elevational end (Column 2, Lines 37 – 45) and wherein said one elevational end of said laminated sheet papers is clamped in such a direction as to depress said laminated sheet papers (Figure 5, Items 16a, 16b depress the sheets in a horizontal direction) with said adhesive left in half-dried condition (sheets are inherently clamped when drying or else sheets would come apart after being flattened and adhesive would not secure sheets properly). Holmberg further discloses flattening the

sheets before applying adhesive (Column 2, Lines 37 – 45; Figure 5, Item 20 where the roller flatten the sheets)

Holmberg does not disclose roughening an elevational surface of said one elevational end extended beyond said pressure surfaces by means of a specified tool; and applying an adhesive to said roughened elevational surface to bond said one elevational end of said laminated sheet papers.

Blair teaches of flattening a set of sheets 6 (Column 2, Lines 1 – 9) before adhesive is applied and even further before the adhesive is applied the bottom edge of the sheets is roughened (Column 4, Lines 58 – 70; furthermore if it is roughened a tool must be used). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide the sheets of Holmberg with a roughened surface in order to promote adhering sheets to one another without destroying or affecting the display surfaces of the sheets.

4. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Holmberg in view of Blair and Leu (U.S. 5,716,182).

In regards to Claim 11, Holmberg modified by Blair does not disclose wherein the roughened elevational surface is tapped to permeate said adhesive between said laminated sheet papers after said adhesive is applied to the roughened elevational surface.

Leu teaches of binding sheets wherein a tool 20 is used to tap sheets and transfer adhesive thereto after tapping the sheets (Column 6, Lines 62 – 67 → Column 7, Lines 1 - 12; Figure 4). Therefore it would have been obvious to a person having

ordinary skill in the art at the time the invention was made to tap the sheets of Holmberg modified by Blair in order to further allow for adhesive to bind the sheets to one another still without seeping of adhesive to the displayed surfaces.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 2, 3, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Holmberg.

In regards to Claims 2 and 3, please review the rejection of Claim 1 with respect to Holmberg as much of the material is identical. Furthermore said clutch pieces having auxiliary legs, or as in Claim 3 are side edge portions to the clutch pieces, each having a flat surface extending in parallel from an upper edge of both sides of said pressure surfaces (Figure 5, Item 16 shows that behind 16b is a leg that goes over the table and is parallel to the upper edge of 16b and the flat item behind 16a has a width dimension which can be treated as a leg and it also is parallel to the upper edge of 16a). With respect to the auxiliary legs to be in parallel with a surface of said work table, and said flat surface being brought to encounter the surface of said work table so as to make said clutch pieces stand on said work table invertedly; even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of

production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). The legs as discussed can be used to balance the clutch pieces on a table in certain orientations invertedly or in a 90 degree position where pressure surfaces extend in parallel with the surface of the work table.

In regards to Claim 13, Holmberg further discloses wherein a sash-like plate is provided behind said pressure surfaces to form a space with an elevational side of said pressure surfaces (Figure 5, plate like item behind 16a; there is a space when in contact with extrusion attached to 16a).

Allowable Subject Matter

Claims 7, 9, and 14 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

In regards to Claims 7 and 9 the prior art does not teach wherein the movable piece supported by the support member is adapted to move toward and away from the main support member when adjusting the space between the pressure surfaces.

In regards to Claim 14, it is not obvious to change the clamping members from a handle that turns to a set of two wing nuts as this would no longer teach of a vice which is taught by Holmberg.

Claim 8 is further objected to as being dependent from Claim 7.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PRADEEP C. BATTULA whose telephone number is (571)272-2142. The examiner can normally be reached on Mon. - Thurs. & alternating Fri. 7:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dana Ross can be reached on 571-272-4480. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/P. C. B./
Examiner, Art Unit 3725
May 18, 2009

/Dana Ross/
Supervisory Patent Examiner, Art Unit 3725